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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER SCARITO, JOHN D	
			ART UNIT 4172	PAPER NUMBER
			MAIL DATE 11/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/709,707

Applicant(s)

THOMAS, TRACEY R.

Examiner

John D. Scarito

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 1-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :5/24/04, 6/1/04, 6/27/06, 7/28/06.

DETAILED ACTION

Specification Objection

Applicant's specification is objected to under 37 CFR 1.52(b)(2)(ii). All text must be written in a nonscript type font (e.g., Arial, Times Roman, or Courier, preferably a font size of 12) lettering style having capital letters which should be at least 0.3175 cm (0.125 inch) high, but may be no smaller than 0.21 cm. (0.08 inch) high (e.g., a font size of 6).

Applicant's submitted abstract, specification, and claims utilize a font size of at least 17. As per the MPEP, a font size of 12 is preferred.

Claim Objections

Claims 1-12 are objected to because of the following informalities:

1. The numbering of Claims 1-12 is not in accordance with 37 CFR 1.126. Since the original numbering of the claims must be preserved throughout prosecution, Applicant must individually number all claims with Arabic numerals (e.g. "1.") in lieu of shorthand margin references (e.g. [c1]).
2. Claims 8-10 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Examiner is unclear how "obtaining information related to user loyalty points", etc. further limits "acquiring user income".

Appropriate correction is required.

Double Patenting

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 13 of copending Application No. 10/709,701.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both Claims (1) receive/input “financial information”, (2) provide a “recommendation” (3) establish/provide a “payment hierarchy”, (4) acquire/store “income”, (5) transfer/payee configured to receive “income” and (5) a “loyalty point” system.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Further, Claim 8 is objected to under 37 CFR 1.75 as being a substantial duplicate of Claim 9. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-5 & 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claim 3, the term “substantially” is a relative term, which renders the claim indefinite. The term “substantially” is not defined by the claim and the specification does not provide a standard for ascertaining its requisite degree. As such, Examiner is concerned that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention as claimed. For example, is it “substantially equal” if 70% of the goal is transferred....or 80%....or 95%, etc?

As per Claims 4 & 5, the term "substantial" is a relative term, which renders the claims indefinite. The term "substantial" is not defined by the claim and the specification does not provide a standard for ascertaining its requisite degree. Here, Examiner is concerned that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention as claimed. For example, is it “substantial compliance” if 26 out of 52 payments are made in accordance with the hierarchy....or 39 out of 52...or 49 out of 52, etc.?

As per Claim 12, “said system transfers” lacks antecedent basis. Applicant is claiming a method which does not reference “a system”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by VanLeeuwen (10/024,128) [Pub. No.: 2002/0123949] (hereinafter “VanLee (‘128)”).

As per Claim 1, VanLee (‘128) teaches the method as follows:

receiving user financial information [paragraph 25, “user is able to input personalized data”], wherein said financial information includes at least one of user income information related to user income [paragraph 26, “bank account information” & paragraph 4], user income source information related to user income sources [see paragraph 72], user debt information related to user debts to payees [paragraph 25, “data input...setting up the bills to be paid” & paragraph 10] and user goal information related to user goals [see paragraph 58, “help them reach their financial goals”]; providing at least one recommendation, wherein said recommendation includes suggestions for minimizing user debt payments and maximizing user savings [see paragraph 24, “a debt plan and its associated recommendations.” Here, Examiner notes that all debt management plans ultimately aim to minimize debt payments and maximize savings. If meant literally, VanLee (‘128) appreciates entering “minimum payments” but such action would “extend the [debt] almost indefinitely”(paragraph 45).]; establishing a payment hierarchy based at least in part on said recommendation [see paragraph 11, “creating a numerical ranking for each of the debts” & Figure 6], wherein said payment

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hierarchy includes at least a portion of said user income allocated to said user savings account and a portion of said user income allocated to said user debts [see paragraph 28, “users...to see the amounts they are spending in each category and the amounts they have allocated”, “data collected is categorized into budget categories” & see paragraph 27, budget categories include “cash outflows (debts) [and] investment [savings]” & paragraph 28, “short-term, mid-term, and long-term funding” & see paragraph 30, “future spending (savings category) & paragraph 85, “money saving strategies”];

acquiring user income [see paragraph 25, “bill presentment and payment system”, user can set up “payment preferences [and] the bills to be paid”. As such, this inherently requires control of user income through the “establish[ed] bank account[s]”].

transferring at least a portion of said user income, based at least in part upon said payment hierarchy, to at least one of user savings account and payees [see paragraph 26, “integrated bill presentment and payment system” in accordance with the “planned spending budget”]; and,

providing loyalty points to at least one of said user, income source and payee [see paragraphs 31, “incentive to help them save money” & “awards points”].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanLeeuwen (10/024,128) [Pub. No.: 2002/0123949] (hereinafter "VanLee ('128)") in view of Ogilvie (6,631,358).

As per Claim 2, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose providing loyalty points based upon at least one of acquiring step and transferring step. Here, VanLee ('128) does disclose offering an incentive in response to "progress the user is making...on the debt reduction program." To make progress, this necessarily involves the transfer of finances in paying off debts, etc, in line with the recommendation or hierarchy disclosed. Regardless, Ogilvie ('358) teaches that incentives are issued per "an agreement, a specified percentage of the transaction or a flat amount." [see Abstract]. A transaction amount is a certain, tangible number that entities have access to and from which incentives can be determined/calculated. As such, it would have been obvious to one of ordinary skill in the art, at the time of Applicant's invention, to modify VanLee ('128) to include providing loyalty points in response to transactions (cash flows) through at least one of the acquiring income or transferring income step.

As per Claim 3, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose providing loyalty points based upon said transferring step, wherein said transferring step transfers said user income to said user savings in such an amount which is substantially equal to said user goal. Regardless, basing loyalty points on a "transfer" transaction is obvious under the logic of Claim 2 above. Further, the point of the debt management method of VanLee ('128) is to reach financial goals [see paragraph 72] and accommodate "future planning" needs (savings) [see paragraph 29]. An incentive, by definition, provides motivation to conform to certain action. As such, it would have been obvious to one of ordinary skill in the art, at the time of Applicant's invention, to modify VanLee ('128) to include providing loyalty points, in response to transfers "substantially equal to said user goal" to "provide encouragement...[in] the debt reduction program" [paragraph 31].

As per Claim 4, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose providing loyalty points based upon said transferring step, wherein said transferring step transfers said user income to said user savings in substantial compliance with said payment hierarchy. Regardless, basing loyalty points on a "transfer" transaction is obvious under the logic of Claim 2 above. Further, the debt management method of VanLee ('128) encourages adherence to a ranking/hierarchy to not only "reduce a person's overall financial debt" [see paragraph 11] but also to accommodate "anticipate[d] future spending needs" [see paragraph 29]. An incentive, by definition, provides motivation to conform to certain action. As such, it would have been obvious to one of ordinary skill in the art, at the time of Applicant's invention, to modify VanLee ('128) to include providing loyalty points, in response to "said user savings" transfers "in

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substantial compliance with said payment hierarchy” to “provide encouragement...[in] the debt reduction program” [paragraph 31].

As per Claim 5, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose providing loyalty points based upon said transferring step, wherein said transferring step transfers said user income to said user debts in substantial compliance with said payment hierarchy. Regardless, basing loyalty points on a “transfer” transaction is obvious under the logic of Claim 2 above. Further, the debt management method of VanLee ('128) encourages adherence to a ranking/hierarchy to not only “reduce a person’s overall financial debt” [see paragraph 11] but also to accommodate “anticipate[d] future spending needs” [see paragraph 29]. An incentive, by definition, provides motivation to conform to certain action. As such, it would have been obvious to one of ordinary skill in the art, at the time of Applicant’s invention, to modify VanLee ('128) to include providing loyalty points, in response to “said user debt” transfers “in substantial compliance with said payment hierarchy” to “provide encouragement...[in] the debt reduction program” [paragraph 31].

As per Claim 6, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose providing loyalty points based upon said transferring step, wherein said transferring step transfers a certain amount of said user income to said user debts, wherein said certain amount is a minimum amount due for said user debts. Regardless, basing loyalty points on a “transfer” transaction is obvious under the logic of Claim 2 above. Further, VanLee ('128) teaches the user option of transferring a certain amount comprising the “minimum payment” for user debts. [see paragraph 45].

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As per Claim 7, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose providing loyalty points based upon said transferring step occurring automatically without user approval. Regardless, basing loyalty points on a "transfer" transaction is obvious under the logic of Claim 2 above. Further, VanLee ('128) teaches that transfers can occur without user approval. [see paragraph 26, "can be setup [sic] for manual bill approval by the user [OR] setup [sic] to forward all bills directly to a remote location for processing."].

Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanLeeuwen (10/024,128) [Pub. No.: 2002/0123949] (hereinafter "VanLee ('128)") in view of Postrel (6,594,640).

As per Claim 8, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose obtaining information related to user loyalty points and converting said loyalty points to a currency value. Regardless, Postrel ('640) teaches exchanging "a number of reward points" for "consideration" [column 4, lines 13-16] where the "consideration may be in the form of a monetary credit. [see column 6, lines 44-46]. As such, it is inherent that point systems are connected to a formulaic value computation; otherwise "consideration" could not be determined by the system of Postrel ('640). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of Applicant's invention, to modify VanLee ('128) to include obtaining conversion information for the computation of the currency value of loyalty points.

As per Claim 9, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose obtaining information related to user loyalty points maintained

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in a third party loyalty system and converting said loyalty points to a currency value. Regardless, Postrel ('640) discloses the retrieval of third party loyalty points and the conversion of them to a currency value. [see column 4, lines 9-10 & 13-16 & column 6, lines 44-46]. Further, prior art loyalty methods, such as VanLee ('128), contemplate the involvement of [p]artnerships with other providers or retail outlets" [see paragraph 31]. As such, it would have been obvious to one of ordinary skill in the art, at the time of Applicant's invention, to modify VanLee ('128) to include obtaining conversion information for the computation of the currency value of loyalty points from third parties.

As per Claim 10, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose obtaining information related to user loyalty points, converting said loyalty points to a currency value and applying said currency value to at least one of said user savings account and user debts. Regardless, obtaining information related to loyalty points and their conversion to a currency value is obvious under the logic of Claim 8 above. Further, VanLee ('128) contemplates "appl[ying cash value] to either debt reduction...or another future fund specified by the user (savings)." [see paragraph 32].

As per Claim 11, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose a third party providing [loyalty points] to at least one of said user, income source and payee. Regardless, Postrel ('640) discloses that third parties provide loyalty points [see Abstract, "plurality of independent reward points issuing entities"]. Further, prior art methods, such as VanLee ('128), contemplate "partners that provide cash back (mere form of "loyalty points", given a conversion rate) on purchases a user makes." [see paragraph 32]. An incentive, by definition, provides motivation to

conform to certain action. This is true, regardless of the party being encouraged. As such, it would have been obvious to one of ordinary skill in the art, at the time of Applicant's invention, to modify VanLee ('128) to include a third party providing loyalty points to a user, income source, or payee involved.

As per Claim 12, VanLee ('128) teaches the method of Claim 1 above. However, VanLee ('128) does not specifically disclose a third party providing loyalty points to at least one of said user, income source and payee based upon said transferring step, wherein said system transfers user income to a user savings account maintained by said third party. Regardless, Postrel ('640) discloses that third parties provide loyalty points [see Abstract, "plurality of independent reward points issuing entities"]. Further, prior art methods, such as VanLee ('128), contemplate "partners that provide cash back (mere form of "loyalty points", given a conversion rate) on [transactions a] user makes." [see paragraph 32]. An incentive, by definition, provides motivation to conform to certain action. This is true, regardless of the party being encouraged. It is good business sense that an investor would prefer to transfer money to a savings account maintained by a third party offering loyalty point incentives over one that does not. As such, it would have been obvious to one of ordinary skill in the art, at the time of Applicant's invention, to modify VanLee ('128) to include a third party, maintaining a user savings account, which provides loyalty points to another party in response to a transaction to said savings account.

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Prior Art

The following prior art made of record, but not relied upon, is considered pertinent to applicant's disclosure: Compiano (10/168,871) (Pub. No. 2003/0208445) and Dent et al (6,128,603).

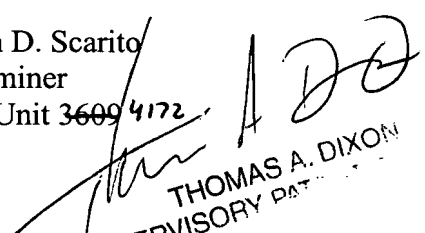
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Scarito whose telephone number is (571) 270-³⁴⁴⁸~~1582~~. The examiner can normally be reached on M-Th (7:30-5:00), Alternate F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John D. Scarito
Examiner
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THOMAS A. DIXON
SUPERVISORY PATENT EXAMINER
